

## REMARKS

1. **Rejection of claims 1-3, 5 and 6 under 35 U.S.C. 102(b) as anticipated by DeJovine (U.S. Patent No. 4,144,166)**

Claims 1-3, 5 and 6 have been rejected as being anticipated by DeJovine.

It is the PTO's position that DeJovine discloses an embodiment wherein the polymer used to support the additive particles is relatively oil-insoluble. The PTO further indicates that since the type of polymeric binder utilized by DeJovine is the same as that utilized by Applicant, the polymeric binder of the reference must inherently have the same solubility characteristics in oil, as does Applicant's polymeric binder. The PTO states:

[a]ccordingly, in this embodiment, the antioxidants will also appear to be retained within the filter for a significant period of time, for the same reason that Applicant's material produces this result. Moreover, even if the polymer employed by DeJovine is oil-soluble, the oil additive particles of this reference filter will only be released into the oil during its use; and prior to such use, these additive particles will also be retained in the filter, as recited in the claims of this application.

*(Office Action of 1/6/04, page 4)*

Applicants greatly appreciate the detailed basis of rejection, but must respectfully disagree. Applicants' independent claim 1 has been amended to more clearly define the claimed invention. As such, the claimed invention now indicates that the beneficial additive consists essentially of an antioxidant or a mixture of a basic salt and an antioxidant. Support for this amendment may be found on page 7, lines 18-24, and page 8, lines 1-9.

In contrast, the solid particles of DeJovine that are released into the circulating lubricating oil are illustrated by graphite, molybdenum disulfide, zinc oxide, tungsten disulfide, mica, boron nitride, borax, silver sulfate, cadmium iodide, lead iodide, barium fluoride, tin sulfide, mixtures thereof, and the like. (*See '166, col. 4, lines 54-63*)

As a result, DeJovine does not anticipate the claimed invention wherein the beneficial additive consists essentially of a basic salt and an antioxidant or an antioxidant alone. DeJovine's solid particles require material that is outside the scope of Applicants' amended independent claim 1. Reconsideration and removal of the rejection is respectfully requested.

2. **Rejection of claim 4 under 35 U.S.C. 103(a) as obvious over DeJovine (U.S. Patent No. 4,144,166) in view of Bilski et al., (U.S. Patent No. 5,725,031).**

It is the PTO's position that it would have been obvious to one of ordinary skill in the art at the time the invention was made to locate the chemically active filter element (i.e. 2) of the DeJovine device inside the mechanically active filter element (i.e. 4), as suggested by Bilski et al., in order to produce a more compact filtration and treatment device.

Applicants appreciate the detailed basis of rejection but must respectfully disagree. Bilski does not rectify the above noted deficiencies of DeJovine. That is, Bilski does not teach or suggest the use of Applicants' particularly required beneficial additive as set forth in amended independent claim 1.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must some suggestion or motivation, either in the references themselves

or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143.

The cited combination of DeJovine and Bilski fails to suggest the necessary modifications that would result in Applicants' claimed oil filter. Accordingly, the cited combination fails to provide a prima facie case of obviousness. Reconsideration and removal of the rejection is respectfully requested.

3. **Rejection of claims 7-10 and 13-16 under 35 U.S.C. 103(a) as obvious over DeJovine (U.S. Patent No. 4,144,166) in view of Brownawell et al., (U.S. Patent No. 5,225,081).**

Brownawell appears to be relied upon by the PTO for its disclosure of an oil filter having both a mechanically active filter member and a chemically active filter member, and the illustration of a filter housing and supplemental cartridge having the recited construction.

Applicants appreciate the detailed basis of rejection but must respectfully disagree. Brownawell does not rectify the above noted deficiencies of DeJovine. That is, Brownawell does not teach or suggest the use of Applicants' particularly required beneficial additive as set forth in amended independent claim 1. Nor does Brownawell teach that such beneficial additives are released into the circulating oil.

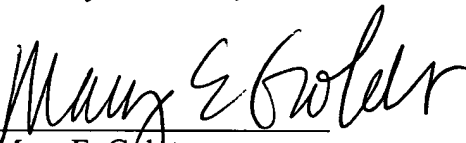
The cited combination of DeJovine and Brownawell fails to suggest the necessary modifications that would result in Applicants' claimed oil filter. Accordingly,

the cited combination fails to provide a prima facie case of obviousness. Reconsideration and removal of the rejection is respectfully requested.

If for any reason the Examiner feels that consultation with Applicant's attorney would be helpful in the advancement of the prosecution, he is invited to call the telephone number below for an interview.

If there are any charges due with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,

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